

Application No. 10/749,761
Response dated January 26, 2005
Reply to Office Action of November 2, 2004

REMARKS

Claims 1-46 are presented for Examiner Chapman's consideration.

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the following remarks is respectfully requested.

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Response to Rejections

By way of the Office Action mailed November 2, 2004, claims 1, 2, 3, 5, 7, 9-13, 15, 16, 21, 24, 26-28, 30-32, 35, 37, 39, 41-43, 45, and 46 stand rejected under 35 U.S.C. § 102 as allegedly being anticipated and thus unpatentable over U.S. Patent Number 5,037,416 to Allen *et al.* (*Allen*). This rejection is respectfully traversed to the extent that it may apply to the claims as filed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 referencing *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990); *see also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Also, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." M.P.E.P. § 2131 (citing *Richardson*, 868 F.2d at 1236 (Fed. Cir. 1989)).

Allen does not anticipate each and every element of Applicants' claims 1, 16, 17 and 31. Claims 1, 16, 17 and 31 require "the front piece and the back piece [be] elastic in a lateral direction . . . the crotch piece [be] elastic in a longitudinal direction . . ." The Examiner states that "Allen discloses . . . a front piece (42) and a back piece (44) which are elastic in the lateral direction (col. 7, lines 5-6) and a crotch piece (46) which is elastic in the longitudinal direction 50) (col. 4, lines 19-24) . . ." The Examiner also states that, "The elastic inner layer may have zones of differing elastic properties (col. 13, line 41)."

Applicants respectfully disagree with the Examiner's reading of *Allen*. Column 7, lines 5-6 of *Allen* state, "the topsheet 12 is elastically extensible is generally parallel to the longitudinal axis A-A . . ." Column 4, lines 19-24 of *Allen* state, "The elastic members 19 are operatively associated with both longitudinal portions 50 and the crotch 46 of the diaper 10 in an elastically contractible condition, so that in the normally unrestrained configuration, the elastic members 19 gather or contract the longitudinal marginal portions 50."

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The citation does not teach, expressly or inherently, each and every element of Applicants' claim 1. First, Allen does not disclose a front piece and a back piece being elastic in a lateral direction and a crotch piece being elastic in a longitudinal direction as required by the claims. Second, Applicants' claim recites a specific arrangement. *Allen* does not teach the elements arranged as required by the claims. M.P.E.P. § 2131. The Examiner relies on the elastic members 19 for the elastic inner layer. However, the elastic members of *Allen* do not refer to the topsheet, but to a separate element that may be joined to the backsheet. Because *Allen* fails to teach each and every element of Applicants' claims 1, 16, 17 and 31, this rejection should be withdrawn.

Likewise, claims 2, 3, 5, 7, 9-13, 15, 21, 24, 26-28, 30, 32, 35, 37, 39, 41-43, 45, and 46 depend from either claims 1, 17, or 31 and are patentably distinct over *Allen* for at least the same reasons as discussed above. Applicants respectfully request that the rejection as to these claims be withdrawn.

By way of the Office Action mailed November 2, 2004, claims 14, 29 and 44 stand rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 5,037,416 to Allen *et al.* (*Allen*) in view of U.S. Patent Number 5,269,775 to Freeland *et al.* (*Freeland*). This rejection is respectfully traversed to the extent that it may apply to the claims as filed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. M.P.E.P. § 2142, 2143.

As discussed above, *Allen* fails to teach an elastic inner layer including a front piece and a back piece that are elastic in a lateral direction and a crotch piece that is elastic in a

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longitudinal direction as required by Applicants' claims 14, 29, and 44 which depend from claims 1, 17 and 31. The addition of *Freeland* does not cure this defect and in fact teaches away. *Freeland* specifically teaches a front section having no elastic extensibility.

Therefore, neither *Allen* nor *Freeland*, alone or in combination, teach or suggest all Applicants' claim limitations. Therefore claims 14, 29 and 44 are nonobvious over the combination of *Allen* and *Freeland*. Applicants respectfully request that the rejection as to these claims be withdrawn.

By way of the Office Action mailed November 2, 2004, claims 4, 17, 18, 19, 20, 33 and 34 stand rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 5,037,416 to Allen *et al.* (*Allen*) in view of U.S. Patent Number 4,756,709 to Stevens (*Stevens*). This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

As discussed above, *Allen* fails to teach an elastic inner layer including a front piece and a back piece that are elastic in a lateral direction and a crotch piece that is elastic in a longitudinal direction as required by Applicants' claims 4, 18, 19, 20, 33 and 34 which depend from claims 1, 17 and 31 (excluding independent claim 18). The addition of *Stevens* does not cure this defect. *Stevens* does not teach an elastic inner layer. Therefore, neither *Allen* nor *Stevens*, alone or in combination, teach or suggest all Applicants' claim limitations. Therefore claims 4, 18, 19, 20, 33 and 34 are nonobvious over the combination of *Allen* and *Stevens*. Applicants respectfully request that the rejection as to these claims be withdrawn.

By way of the Office Action mailed November 2, 2004, claims 6, 8, 22, 23, 36 and 38 stand rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 5,037,416 to Allen *et al.* (*Allen*) in view of U.S. Patent Number 5,817,086 to

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Kling et al. (Kling). This rejection is respectfully traversed to the extent that it may apply to the claims as filed.

As discussed above, *Allen* fails to teach an elastic inner layer including a front piece and a back piece that are elastic in a lateral direction and a crotch piece that is elastic in a longitudinal direction as required by Applicants' claims 6, 8, 22, 23, 36 and 38 which depend from claims 1, 17, and 31. The addition of *Kling* does not cure this defect. Therefore, neither *Allen* nor *Kling*, alone or in combination, teach or suggest all Applicants' claim limitations. Therefore claims 6, 8, 22, 23, 36 and 38 are nonobvious over the combination of *Allen* and *Kling*. Applicants respectfully request that the rejection as to these claims be withdrawn.

For at least the reasons stated above, it is respectfully submitted that all of the presently presented claims are in form for allowance.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: (920) 721-3016.

Respectfully submitted,

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